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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,095	12/10/2003	Till Gerlach	54174	4508

7590

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EXAMINER

DAVIS, BRIAN J

ART UNIT	PAPER NUMBER
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1621

DATE MAILED: 05/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/731,095	Applicant(s) GERLACH ET AL.	
	Examiner Brian J. Davis	Art Unit 1621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 July 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>12/10/03;7/15/04</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: there are innumerable instances of incomplete words, for instance, on page 1 line 16, "us" (instead of "use"); on page 3 line 3, "stabe" (instead of "stable"); page 3 line 4, "t tragonal" (instead of "tetragonal"). Other instances are similar. Appropriate correction is required. Applicant's assistance is respectfully requested in corrected any and all other minor grammatical and/or spelling errors which may be present in the text.

The specification is also objected to because it does not contain a Brief Description of the Drawing (heading and brief explanation of the drawing).

Drawings

The drawings are objected to because the figure should be clearly labeled i.e. "Figure 1". Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for

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consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

Claim 15 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The independent claim is a method claim. Claim 15, a compound claim, merely claims the catalyst of the independent claim.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the preparation of symmetrical secondary amines of the formula I from primary amines of formula II or IIa in the presence of hydrogen and

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a zirconium dioxide supported catalyst, does not reasonably provide enablement for the universe of symmetrical secondary amines prepared from the universe of primary amines in the presence of hydrogen and a zirconium dioxide supported catalyst. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

With regard to rejections under 35 USC 112, first paragraph, the following factors are considered (*In re Wands* 8 USPQ 2d 1400, 1404 (CAFC 1988)): a) Breadth of claims; b) Nature of invention; c) State of the prior art; d) Level of ordinary skill in the art; e) Level of predictability in the art; f) Amount of direction and guidance provided by the inventor; g) Working examples and; h) Level of experimentation needed to make or use the invention based on the content of the disclosure.

a)The claims are quite broad with respect to the compound prepared and starting materials used: the *universe* of symmetrical secondary amines and the *universe* of primary amines, respectively.

b,c)The nature of the invention is determined in part by the state of the prior art. The prior art in general teaches processes related to that of the instant invention under specific reaction conditions. That is, starting materials, products, solvents, catalysts, temperature ranges etc. are explicitly defined.

d)The level of skill in the art is considered to be relatively high.

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e)The level of predictability in the art is considered to be relatively low. Even under the best of circumstances, and several hundred years after Lavoisier laid the foundations of its modern practice, chemistry remains an experimental science.

f,g)The amount of direction provided by the inventor is considered to be determined by the specification and the working examples. Applicant provides exactly one working example in accordance with the claimed invention: the preparation of bis-DMAPA from DMAPA.

h) Applicant's single working example of the preparation of a single symmetrical secondary amine from a single primary amine cannot reasonably be extrapolated to encompass the preparation of the universe of symmetrical secondary amines from the universe of primary amines. It is not possible to make and use the instant invention without an undue level of experimentation. The specification must teach how to make and use the invention, not how to figure out for oneself how to make and use the invention. *In re Gardner*, 166 USPQ 138 (CCPA 1970).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 9 recites the limitation "molar ratio of nickel to copper."

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There is insufficient antecedent basis for this limitation in the claim. That is, there is no basis in claim 5 for a mixture of catalytic metals.

Claims 13 and 14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "such as" renders the claims indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 15 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by US 6,034,029, cited by the applicant in the IDS. Claim 15 is drawn to a catalyst whose limitation is set forth in claim 1: "...a catalyst whose preparation has involved precipitation of catalytically active components onto monoclinic, tetragonal or cubic zirconium dioxide." (The additional limitations which appear in claim 15 carry no patentable weight because: A compound and its properties are inseparable. *In re Papesch*, 315, F.2d 381, 137 USPQ 43 (CCPA 1963).) US 6,034,029 teaches, inter alia, monoclinic zirconium dioxide doped with catalytically active metals (column 3 line 64 – column 4 line 25).

Allowable Subject Matter

The subject matter of claims 13 and 14 would be allowable once the rejections outlined in this Office Action have been overcome.

The key to the instant invention is the precipitation onto monoclinic, tetragonal or cubic zirconium dioxide of catalytically active components. The closest prior art appears to be DE 3048832, cited in the IDS and outlined in the specification, and US 4,914,241. Both references teach the synthesis of symmetrical amines. However, neither reference teaches or suggests using the instant zirconium dioxide supported catalysts. While it is clear that the chemical arts recognize the usefulness of, for instance, doped monoclinic zirconium dioxide catalysts in a variety of reactions (US 6,034,029 column 4 line 25), and while it may have been, at best, obvious to try a doped zirconium dioxide supported catalyst in the instant process, an 'obvious to try' standard is impermissible in two situations: 1) where the prior art gives no indication as to which of numerous parameters are critical, or gives no indication as to which of many possible choices is likely to be successful; and 2) where the prior art gives only general guidance with respect to the form of the invention but not how to achieve it new areas of technology or in fields of experimentation which are only seemingly promising. *In re O'Farrell*, 853 F2d 894, 7 USPQ 2d 1673, 1681 (Fed. Cir. 1988). In the instant application, both 1) and 2) above apply.

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian J. Davis whose telephone number is 571-272-0638. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



BRIAN DAVIS
PRIMARY EXAMINER

Brian J. Davis
April 27, 2005